

**REMARKS**

The present application has been reviewed in light of the Office Action dated October 31, 2006. Claims 26-54 are currently pending. By the present amendment, Claim 37 has been amended. It is respectfully submitted that this amendment adds no new matter and is fully supported by the specification. In view of the amendment above and the remarks that follow, it is respectfully submitted that the claims pending in the present application are patentable over the prior art. Accordingly, reconsideration of the present application is respectfully requested.

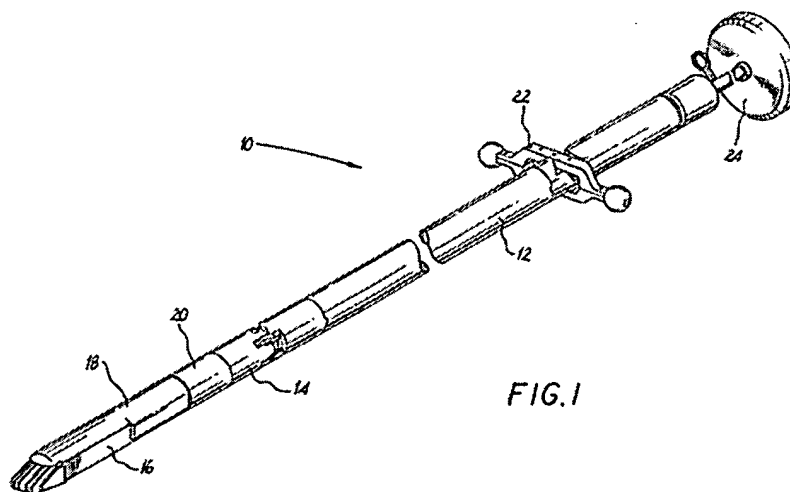
The Office Action rejected Claim 37 under 35 U.S.C. § 112, second paragraph, as being indefinite. More particularly, Claim 37 was rejected for including limitations that lacked antecedent basis. Claim 37 has been amended herein to remove the indefinite language identified by the Examiner. In view of this amendment, Applicant respectfully requests that the rejection of Claim 37 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Office Action, Claims 26, 27, 34-37, 42, 43, and 45-47 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,485,952 to Fontayne (hereinafter "Fontayne"). It is respectfully submitted, however, that Fontayne fails to disclose, teach, or suggest the tool assembly recited in independent Claim 26.

Independent Claim 26 recites, *inter alia*, an anvil, a cartridge assembly, a clamp member, and "a dynamic clamping member movably positioned in relation to the anvil and the cartridge assembly, the dynamic clamping member being movable from a first position to a second position to define a maximum tissue gap between the cartridge assembly and the anvil adjacent the dynamic clamping member during ejection of the plurality of fasteners from the cartridge

assembly.”

Fontayne discloses a surgical stapling apparatus 10, shown in FIG. 1 reproduced below, comprising, *inter alia*, a cartridge housing 16, an anvil member 18, and a collar tube 90 for camming anvil member 18 between open and closed positions. An actuator rod 286 is also movable to drive pusher elements upwardly to urge staples 302 from a cartridge element 300. See FIG. 4 reproduced below.



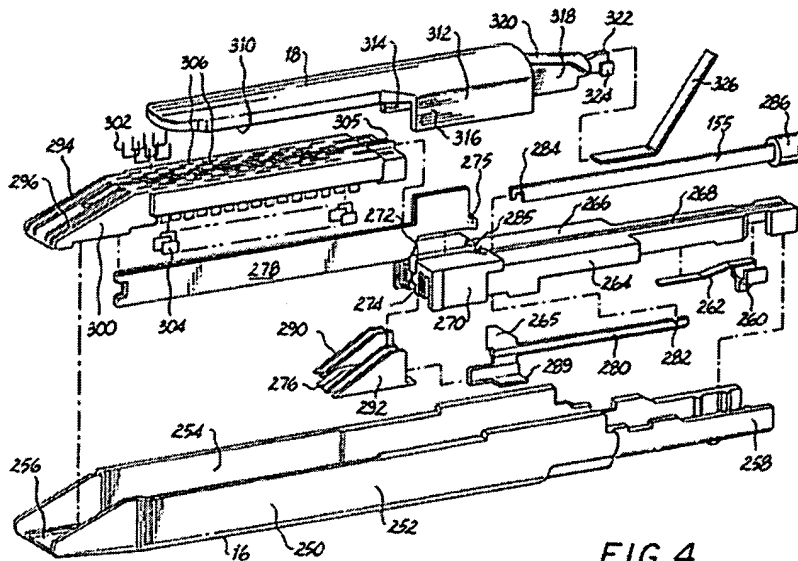


FIG. 4

Under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

In the Office Action, the Examiner asserts that Fontayne discloses a tool assembly including, *inter alia*, an anvil, a cartridge assembly, and “a dynamic clamping member movably positioned in relation to the anvil and the cartridge assembly”, and that Fontayne, therefore anticipates independent Claim 26. Applicant respectfully suggests, however, that Fontayne fails to disclose, teach, or suggest the dynamic clamping member recited in independent Claim 26. Claim 26 requires a dynamic clamping member movably positioned in relation to the anvil and the cartridge assembly to define a maximum tissue gap between the cartridge assembly and the

anvil adjacent the dynamic clamping member during ejection of the plurality of fasteners from the cartridge assembly. The specification indicates that the use of a dynamic clamping or closure member “which clamps as it translates along the tool member helps to compensate for fluid flow and/or from within the tissue and/or bowing out of the distal end of the anvil and thereby ***maintain the desired tissue gap between the anvil and the cartridge assembly.***” (See page 13, lines 13-16). The driving mechanism and camming assembly disclosed in Fontayne and likened to the dynamic clamping member recited in independent Claim 26 by the Examiner, in contrast, serves merely to urge collar tube 90 in the distal direction to engage the cam surface 320 at the proximal end of the anvil member 18, such that the anvil member 18 is cammed into a closed position. (See col. 8, lines 22-30 and lines 57-67; col. 9, lines 1-4). Claim 26 requires a clamp member “to maintain the proximal end of the cartridge assembly and the anvil in juxtaposed alignment.” Accordingly, Applicant urges that Fontayne fails to disclose, teach, or suggest “a dynamic clamping member movably positioned in relation to the anvil and the cartridge assembly” that serves to “***define a maximum tissue gap between the cartridge assembly and the anvil adjacent the dynamic clamping member during ejection of the plurality of fasteners from the cartridge assembly***”, as recited in independent Claim 26. Therefore, it is respectfully submitted that Fontayne fails to disclose, teach, or suggest, each and every element and limitation set forth in that claim.

In accordance therewith, it is respectfully submitted that Claim 26 is patentably distinguishable over Fontayne and, therefore, allowable under 35 U.S.C. § 102(b). As Claims 27, 34-37, 42-43, and 45-47 depend, directly or indirectly, from Claim 26, for at least the reasons

discussed above with respect to Claim 26, *inter alia*, it is further submitted that these claims, too, are allowable over Fontayne.

In the Office Action, the Examiner rejected Claims 28-33, 40-41, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Fontayne in view of U.S. Patent No. 5,690,269 to Bolanos et al. (hereinafter “Bolanos”). Applicant notes that the “spacer 136” disclosed in Bolanos is fixed by pin 122 to articulating portion 116. Thus, Applicant respectfully submits that, Bolanos does not cure the deficiencies of Fontayne with respect to Claim 26 as discussed above, and that neither Fontayne nor Bolanos, taken alone or in combination, disclose or suggest the tool assembly recited in independent Claim 26.

The Office Action relies on Bolanos for teaching the concept of a drive member having a coaxial drive cable with an outer sheath and a center rod for the purpose of properly articulating an endoscopic portion.

MPEP 706.02(j) indicates that:

“[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

MPEP 706.02(j) further specifies that the burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.

As discussed above, Applicant submits that Fontayne fails to disclose, teach, or suggest the “dynamic clamping member movably positioned in relation to the anvil and the cartridge

assembly” that serves to “define a maximum tissue gap between the cartridge assembly and the anvil” recited in independent Claim 26, as discussed above. The addition of a drive member incorporating a coaxial drive cable with an outer sheath and a center rod, which the Examiner identifies as being disclosed in Bolanos, fails to cure this deficiency. Accordingly, Applicant respectfully submits that none of the references of record, considered individually or in combination, disclose or suggest, in whole or in part, the dynamic clamping member recited in independent Claim 26. Therefore, it is respectfully suggested that the Office Action fails to meet the burden established by MPEP 706.02(j) and that Claim 26 is allowable under 35 U.S.C. § 103(a) over Fontayne in view of Bolanos.

As Claims 28-33, 40-41, and 44 depend, directly or indirectly, from Claim 26, it is further submitted that these claims, too, are allowable.

In the Office Action, the Examiner rejected Claims 38-39 and 48-54 under 35 U.S.C. § 103(a) as being unpatentable over Fontayne in view of U.S. Patent No. 6,669,073 to Milliman et al. (hereinafter “Milliman”). Applicant respectfully submits, however, that neither Fontayne nor Milliman, taken alone or in combination, disclose or suggest the tool assembly recited in each of independent Claims 26 and 48.

The Office Action relies on Milliman for teaching the disclosure of a surgical stapling apparatus comprising a tool assembly with anvil and cartridge assemblies and a clamping member having an upper flange positioned to engage a surface of the anvil.

Claims 38 and 39 depend from Claim 26. As discussed above, Applicant submits that Fontayne fails to disclose, teach, or suggest the “dynamic clamping member movably positioned

in relation to the anvil and the cartridge assembly” that serves to “define a maximum tissue gap between the cartridge assembly and the anvil” recited in independent Claim 26 as discussed above. The addition of an upper flange, which the Examiner suggests is disclosed in Milliman, fails to cure this deficiency. Accordingly, Applicant respectfully urges that the combination of Fontayne and Milliman fails to disclose or suggest the dynamic clamping member recited in independent Claim 26. Accordingly, it is respectfully suggested that Claims 38 and 39, which depend directly or indirectly from Claim 26, are also allowable for at least the reasons discussed above with respect to Claim 26, *inter alia*.

Regarding the rejection of Claims 48-54, independent Claim 48 recites, *inter alia*, an anvil, a cartridge assembly, “a clamp member positioned adjacent a proximal end of the tool assembly . . . to maintain a proximal end of the anvil and cartridge assembly in the approximated position”, and “a dynamic clamping member positioned within the tool assembly . . . including an upper flange portion engaging a surface of the anvil and a lower flange portion engaging a surface of the cartridge assembly, at least one of the upper and lower flange portions having a rounded cross-section along an axis transverse to a longitudinal axis of the cartridge assembly.”

In the Office Action, the Examiner argued that Fontayne in view of Milliman discloses a tool assembly having an anvil, a cartridge assembly, a clamp member, and a dynamic clamping member having upper and lower flange portions positioned to engage the anvil and cartridge assemblies, respectively, thereby rendering Claim 48 unpatentable under 35 U.S.C § 103(a). It is respectfully submitted, however, that Fontayne in view of Milliman fails to disclose or suggest ***both a clamp member*** “positioned adjacent a proximal end of the tool assembly . . . to maintain a

proximal end of the anvil and cartridge assembly in the approximated position” *and* “*a dynamic clamping member* positioned within the tool assembly and movable from a retracted position through the tool assembly to an advanced position to eject staples from the cartridge assembly”.

Stated differently, even if it is assumed that Fontayne in view of Milliman discloses or suggests the dynamic clamping member recited in independent Claim 48, as suggested by the Examiner, there is no such disclosure or suggestion of the clamp member also recited in the claim. Therefore, it is respectfully suggested that Fontayne in view of Milliman fails to teach or suggest all the claim limitations recited in independent Claim 48.

Moreover, Applicant respectfully submits that Fontayne in view of Milliman fails to disclose or suggest a tool assembly comprising, *inter alia*, a dynamic clamping member including upper and lower flanges where at least one of the flanges has “*a rounded cross-section along an axis transverse to a longitudinal axis of the cartridge assembly*”, as recited in independent Claim 48.

As indicated above, under MPEP 706.02(j), the burden is on the Examiner to indicate where “the prior art reference (or references when combined) . . . teach or suggest all the claim limitations.”

Applicant respectfully submits that the Office Action fails to indicate, where the disclosure or suggestion of a dynamic clamping member including upper and lower flanges where at least one of the flanges has “*a rounded cross-section along an axis transverse to a longitudinal axis of the cartridge assembly*” may be found, in either Fontayne or Milliman, taken in whole or in part, together or in combination. Accordingly, it is respectfully suggested



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Amdt. Dated January 26, 2007  
Reply to Office Action of October 31, 2006

that the Office Action has failed to indicate how Fontayne in view of Milliman teaches or suggests all the claim limitations recited in Claim 48.

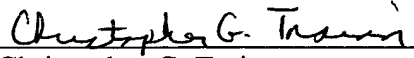
Accordingly, Applicant respectfully submits that the Office Action fails to meet the burden established by MPEP § 706.02(j) regarding rejections under 35 U.S.C. § 103(a) in that the Office Action fails to indicate how Fontayne in view of Milliman teaches or suggests all of the limitations recited in independent Claim 48. Accordingly, it is respectfully submitted that the rejection of independent Claim 48 over Fontayne in view of Milliman under 35 U.S.C. § 103(a) may be properly withdrawn. As Claims 49-54 depend, directly or indirectly, from Claim 48, it is further submitted that the rejection of these claims, too, may be properly withdrawn.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, or resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at the number indicated below.

In view of the foregoing amendments and remarks, reconsideration of the application and allowance of Claims 26-54 is earnestly solicited.

Respectfully submitted,

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